

REMARKS

I. Introduction

Receipt is acknowledged of the Final Office Action dated November 25, 2003 and Advisory Action of April 8, 2004. Applicants filed an Amendment on March 25, 2004 that was not entered. The above amendment assumes that amendment still has not been entered. Currently, claims 34-37 are pending in the application. Claims 36 and 37 are herewith canceled. Thus, with the entry of this amendment, claims 34 and 35 will be pending. No new matter is added in the amendments, which are fully supported by the specification.

II. Rejections under 35 USC § 112

A. Rejections Under 35 USC § 112, second paragraph

The Examiner has rejected claims 36 and 37 under § 112, second paragraph, as not distinctly claiming the subject matter of the invention. Specifically, the Examiner states that with regard to claim 36, it is not clear how one skilled in the art would be able to select the "remaining genes" if there is no information as to which gene is eliminated in the first step. It also is not clear to the Examiner which genes are eliminated or altered and also what is meant by "altered."

In response, applicants assert that this rejection is now moot in view of the cancellation of claims 36 and 37. Withdrawal thereof is therefore respectfully requested.

B. Rejections Under 35 USC § 112, first paragraph

The Examiner has maintained the rejection of claims 34-37 under § 112, first paragraph, for the asserted reason that the specification does not reasonably provide enablement for a method of producing acarbose by expressing one or more fragments of SEQ ID NO:7 (as in claim 34), or a process comprising isolating acarbose from the culture supernatants of the host cell in which all the native acarbose synthesizing genes are eliminated (as in claims 36-37). The Examiner has also stated that it is not clear which of the SEQ ID NO:7 fragments is likely to be successful in synthesizing acarbose. The Examiner has stated that this would require undue experimentation, and the specification is limited to teaching a single species, SEQ. ID NO: 7, of the claimed genus.

In response to this rejection, applicants have amended claim 34 and cancelled claim 36. Claim 34 no longer recites the allegedly objectionable fragments, thereby rendering the Examiner's rejection moot. Support for the hybridization language can be found, *inter alia*, at page 15, lines 14-27. Support for the degeneracy of the code language can be found, *inter alia*, at page 11, lines 24 to 37.

The Examiner's objections to claim 34 in the Advisory Action, have been addressed with the addition of functional language to part (b) and in the deletion from part (c), the allegedly confusing clause.

In view of these remarks and amendments, applicants respectfully request the rejection for lack of enablement be withdrawn.

CONCLUSION

In view of this RCE, amendment and comments, applicants assert that all objections have been obviated and an early notification of allowance is respectfully requested.

Future correspondence in this case should be directed to the address associated with Customer Number 005487, as indicated on that attached Revocation of Power of Attorney and New Power of Attorney.

Respectfully submitted,

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Date

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